

Appl. No. 10/677,232
Amendment dated: May 13, 2005
Reply to OA of: February 16, 2005

REMARKS

Applicants acknowledge with appreciation the courtesy of the interview extended the Applicants' representative by Examiner Lavinder, the Examiner in charge of this application. At the interview the Examiner agreed that the finality of the previous office action should be withdrawn because the Section 112, second paragraph, rejections were only first presented in the most recent Office Action, dated February 16, 2005. Also during the interview, Applicants discussed with the Examiner a set of proposed amendments addressing the §112, second paragraph, rejections. The Examiner indicated that the proposed amendments would overcome these rejections if submitted with the next Response. Thus, Applicants have amended the claims according to the proposed amendment submitted at the Interview, and believe that the above claims are now in full compliance with 35 U.S.C. §112.

The Applicants also wish to thank the Examiner for the insightful suggestions on how to further define the invention in order to overcome the §102(b) and §103(a) rejections. Specifically, the Examiner indicated that further clarifying the position of the clip set section in relation to the cylinder and further clarifying the fixing reference point would put the claims in a better condition for allowance. Applicants believe that the above presented claims represent the incorporation of the Examiner's suggestions.

Thus, in addition to the amendments correcting the §112, second paragraph issues, claim 1 has been amended to recite that the clip set section is formed on the outside of the cylinder and protrudes outwardly from the cylinder. Support for this amendment can be found at, e.g., Figures 1-13 and page 13, 3rd and 4th full paragraphs of the specification. Claim 1 has also been amended to incorporate the limitations of claim 2 and claim 3 in order to place what was indicated as allowable subject matter in the Office Action dated July 30, 2004 into independent form. Accordingly, claims 2, 3, 5, 7 and 8 have been canceled. Applicants most respectfully submit that all claims now

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present in the application are in full compliance with 35 U.S.C. §112 and are clearly patentable over the references of record.

Claims 1-9 have been rejected under 35 U.S.C. 102(b) as being anticipated by Ganz. The office action urges that Ganz discloses a clip fixing structure having a fixing section pushed onto and fitted over a clip section formed on a cylinder to attach a clip to the cylinder. The fixing section has fixing piece sections with a part that functions as a fixing reference point. The clip section has locations at both sides for holding the fixing section to the clip set section. The office action further urges that Ganz discloses engaging sections that are holes and holding sections which are protrusions and further discloses tapers on the upper half sections of the holding sections. The Office Action further states that Ganz discloses the lower portion of the holding sections are formed with stoppers for the fixing pieces and that the Ganz reference discloses an anti-lateral vibration means that functions to prevent lateral movement or vibration between the clip and the clip set section. This rejection have been carefully considered but is most respectfully traversed.

Applicants wish to direct the Examiner's attention to MPEP § 2131 which states that to anticipate a claim, the reference must teach every element of the claim.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed.Cir. 1990).

The present invention is directed to a clip fixing structure wherein the clip set section is located on and outside of the cylinder to which it is attached. This can clearly

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be seen in Figures 1-13 as well as throughout the specification, and the claim language has been amended to further clarify this element of the invention. To the contrary, the Ganz reference clearly shows a clip set section that is within the cylinder. Referring to Figure 1 of Ganz, the clip set section 24 is inserted into the pen cap 12 and thus is not on and outside of the cylinder as required by the presently amended claims. Thus, Ganz fails to teach each and every element of the present invention and is incapable of supporting a proper §102(b) rejection.

With respect to the statement in the Office Action that Ganz discloses a fixing section having fixing piece sections with a part that function as a fixing reference point, Applicants wish to point out that the presently amended claims call for clip set section to serve as a fixing reference point, not the fixing section. The reference numerals indicated in the Office Action as serving as a fixing reference point are all part of the fixing section and not the clip set section as required by the present claim language. Referring to Figure 1 of Ganz, reference numeral 50, reference numeral 56 and reference numeral 54 are all part of the fixing section, which is attached to the clip set section. To the contrary, the present invention requires that the clip set section protrude outwardly from the cylinder in such a way that a part thereof, i.e. the clip set section, becomes a fixing reference point. Thus, Ganz clearly does not recite each and every element of the present claim as currently written.

Thus, for all the foregoing reasons, the §102(b) rejection of claims 1-9 is improper for failing to disclose each and every element of the present invention. Thus, Applicants respectfully request that this rejection be withdrawn.

Claims 10 and 11 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Ganz in view of Saitou. The office action urges that while Ganz fails to disclose engaging sections formed as concaved outward notches and holding sections as protrusions adapted at least to a concave inner contour shape of the engaging section, Saitou discloses that these claim limitations are either disclosed in

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Saitou or clearly design equivalents of the teachings of Saitou. These rejections have been carefully considered but are most traversed.

Applicants wish to direct the Examiner's attention to the basic requirements of a prima facie case of obviousness as set forth in the MPEP § 2143. This section states that to establish a prima facie case of obviousness, three basic criteria first must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Section 2143.03 states that all claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).


Because claims 10 and 11 depend directly from claim 1 and therefore include each and every element of claim 1, Applicants assert that a §103(a) rejection over Ganz is improper for all of the reasons stated above with respect to the §102(b) rejection of claims 1-9. Ganz fails to disclose or suggest each and every limitation of the claimed invention and Applicants therefore respectfully request that this rejection be withdrawn.

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In view of the above comments and further amendments to the claims, favorable reconsideration and allowance of all of the claims now present in the application are most respectfully requested.

Respectfully submitted,

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